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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,011	02/22/2002	Clifford H. Patridge	47097-0110USPT	1903
28763	7590	12/29/2004	EXAMINER	
WINSTON & STRAWN			PASCUA, JES F	
PATENT DEPT			ART UNIT	
1400 L STREET NW			PAPER NUMBER	
WASHINGTON, DC 20005-3502			3727	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/082,011	Applicant(s) PATRIDGE ET AL.	
	Examiner Jes F. Pascua	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 29-46 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 29, 33-35 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-15, 30-32, 36-43, 45, 46 and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 6-15, 31, 32, 36-43, 46, 48 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to set forth the first portion of the bag between the first narrowing seal and the opposite side as incapable of being removed from the remaining portion of the bag (i.e. "non-removably attached"). There is nothing in applicant's specification that would preclude removal of the first portion by cutting.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 6-15, 31, 32, 36-43, 46, 48 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

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In claims 1 and 31, the functional recitation that "the first portion non-removably attached to a remaining portion of the bag" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

5. Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, first and second paragraphs.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 30 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vilutis '801 (previously cited).

8. Claim 30 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wan (previously cited).

9. Claims 1, 2, 8, 46 and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Imazeki et al. (previously cited). See Figs. 5(a) and 5(c).

As a note, Imazeki et al. states that narrowing seals 3b extend inwardly and downwardly. See column 4, lines 3-7.

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10. Claims 1, 2, 8, 9, 13, 31, 32, 38, 39, 43 and 46 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Schönbach et al. (previously cited).

Regarding claims 9 and 39, sealing together of the first and second panels through an innermost layer of polyethylene meets the recitation "first narrowing seal is formed by adhering the first and second panels".

11. Claims 1, 2, 8, 10, 11, 12, 31, 32, 38, 40, 41, 42 and 46 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by LaFleur '251 (previously cited).

12. Claims 1, 2, 6-8, 10-13, 30 and 46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Van Erden et al. (previously cited).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imazeki et al., Schönbach et al. or LaFleur '251.

Imazeki et al., Schönbach et al. and LaFleur '251 each disclose the claimed invention except for the original width of the bag panels being about 24 inches. It would have been an obvious matter of design choice to make the original widths of the bag

panels in Imazeki et al., Schönbach et al. or LaFleur '251 about 24 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imazeki et al., Schönbach et al. or LaFleur '251.

Imazeki et al., Schönbach et al. and LaFleur '251 each disclose the claimed invention except for the second width of the bag panels being about 21 inches. It would have been an obvious matter of design choice to make the second widths of the bag panels in Imazeki et al., Schönbach et al. or LaFleur '251 about 21, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

16. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed invention except for the garbage bag in combination with a container. It would have been an obvious matter of design choice to provide the garbage bag of Wan in combination with a container (such as a trash can), since applicant has not disclosed that combining a container with a garbage bag solves any stated problem or is for any particular purpose and it appears that the Wan garbage bag would perform equally well in combination with a container.

Regarding the recitation, "the second width adapted to grip the bag engaging periphery of the container", it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

As a note Wan discloses that the narrowing seal may extend along one or both of the lateral sides of the bag. See column 1, lines 58-61. Therefore, the recited first and second narrowing seals are met by Wan.

17. Claims 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan and Simonsen.

Wan discloses the claimed device, device as discussed above, except for the first and second layers including at least one tying flap in addition to the tie-strip. Simonsen discloses that it is known in the art to provide at least one tying flap on an analogous bag that has a closure mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bag of Wan with the tying flaps of Simonsen, in order to provide primary and secondary closure means for the garbage bag.

***Allowable Subject Matter***

18. Claims 36, 37 and 50 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

19. Applicant's arguments with respect to claims 1, 2, 6-15, 30-32, 36-43, 45, 46 and 48-51 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 571-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jes F. Pascua  
Primary Examiner  
Art Unit 3727

JFP